

### REMARKS

In an Office Action mailed on August 2, 2006, Claims 1-5 were rejected under 35 U.S.C. § 112. Claims 1-5 were also rejected under 35 U.S.C. § 103(a). In view of the foregoing claim amendments and remarks that follow, applicant respectfully requests reconsideration and allowance of all claims.

#### Rejections under 35 U.S.C. § 112

Claims 1-5 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Further, Claims 1-5 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant regrets these oversights and has amended Claims 1 and 4 accordingly.

In view of the foregoing claim amendments, applicant respectfully submits that the rejections under 35 U.S.C. § 112 have been overcome.

#### Claim Rejections under 35 U.S.C. § 103

To establish a *prima facie* case for obviousness under 35 U.S.C. § 103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 2142 (August 2006).

Claims 1 and 4, as well as certain dependent claims stemming therefrom, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,732,958, issued to Liu, in view of U.S. Patent No. 5,625,999, issued to Buzza et al., and in further view of U.S. Patent No. 5,934,692, issued to Artus. The Office Action sets forth the position that although Liu

LAW OFFICES OF  
CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

teaches the basic claimed process of making a skate frame, it does not teach a second layer and a decorative layer.<sup>1</sup> Buzza et al. is cited by the Office Action as teaching an outer decorative gel layer and, therefore, it would have been obvious to provide the decorative layer and additional inner fiber reinforced resin layer, as taught by Buzza et al. to the process of Liu. Artus is cited by the Office Action as teaching a skate frame having core material only in the shoe load introduction portions.

Applicant respectfully submits that the claims are not rendered obvious because (1) Buzza et al. is a non-analogous patent; and (2) the hypothetical combination of Liu, Buzza et al., and Artus fail to teach or suggest all limitations of amended Claims 1 and 4.

1. Buzza et al. is Non-Analogous Art

According to M.P.E.P. 2141.01(a), it is well settled that "[i]n order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *See e.g. In re Oetiker*, 977 F.2d 1443, 1446, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992). Applicant respectfully submits that the invention of Buzza et al. is neither in the field of applicant's endeavor nor pertinent to the particular problem with which the applicant was concerned.

Buzza et al. concerns a roofing system that includes a fiberglass sandwich panel 100 formed from a molding process. A plurality of fiberglass sandwich panels 100 are attached and

---

<sup>1</sup> Applicant respectfully notes that the Office Action has cited limitations not found in either Claim 1 or 4. As an example, the Office Action sets forth the position that Liu teaches "an outer layer (20) made from a fiber reinforced resin composite material, providing an inner core foam material (30), positioning said inner core (30) between the two side walls (22) of the outer layer (20) that is placed in a mold, heating said mold and, curing said resin to bond said inner core (30) to said outer layer (20) and form said skate frame (See Col. 2, lines 22-30)." Applicant respectfully notes that many limitations cited by the Office Action are not found in either Claim 1 or 4 and, therefore, the disputed claims should not be construed to include such limitations.

assembled to structural steel purlins to form a roofing system. Buzza et al. does not concern molding a core within reinforced layers to produce a strong, lightweight skate frame, as generally taught by applicant's own disclosure. Thus, the method of Buzza et al., which includes making a fiberglass sandwich panel for a roofing system, is not reasonably pertinent to the Liu lay up process or the method of forming a skate of the present claims.

Applicant also notes that Buzza et al. is also not pertinent to the particular problem which the applicant was concerned. As noted in the application as filed, the presently claimed methods of manufacturing an in-line skate frame addressed various issues associated with then existing methods of manufacturing such skate frames. As a non-limiting example, because then existing methods of manufacturing in-line skate frames utilized a "flange extending laterally away from both sides of the upper end of the skate frame," such skate frames were not "very robust in accommodating different skating styles, even for the skater for whom the skate was custom made." (See page 2, line 24 through page 3, line 2).

In contrast, the problem addressed by Buzza et al. dealt with lightweight roofing systems. It is noted that Buzza et al. expressly criticized several prior art patents dealing with roofing systems comprising a plurality of fiber glass sandwiched panels. (Col. 2, lines 38-40). Buzza et al. criticizes the prior art patents for failing to "suggest the use of a sandwich panel having two substantially parallel surfaces and a peripheral edge having a step shape or a roofing system comprising sandwich panels having two shapes with relative dimensions joined at ship-lap joints." (Col. 2, lines 40-44).

Thus, the problems addressed by Buzza et al. are generally directed to lightweight roofing systems. Applicant respectfully submits that because Buzza et al. is neither in the field of applicant's endeavor or pertinent to the particular problem which the applicant was concerned, it is respectfully submitted that Buzza et al. is non-analogous prior art. As a result, the

hypothetical combination suggested in the Office Action to render the claims of the present application unpatentable under 35 U.S.C. § 103 is improper.

2. Hypothetical Combination Fails to Teach or Suggest Disputed Claims

Even assuming that Buzza et al. is deemed to be analogous prior art, applicant respectfully submits that a hypothetical combination of Liu, Buzza et al., and Artus fails to teach or suggest each and every aspect of amended Claims 1 and 4. In that regard, the hypothetical combination fails to teach or suggest a method of constructing a skate frame having core material that is both (i) "absent from the shoe load introduction portion," as is now generally recited in amended Claims 1 and 4; and (ii) either "sealed between the first and second skins," (Claim 1) or sealed "between the first skin and the decorative sheet," (Claim 4).

Liu teaches a skate frame with an inverted U-shaped outer case 20 that receives an inner member 30. The outer case includes an upper plate 21 and two sidewalls 22. The inner member 30 is securely disposed between the two sidewalls 22 of the outer case 20. As shown in Figure 2, the top surface of the inner member 31 abuts the inside surface of the upper plate 21 of the outer case 20. During the molding process, the inner member 30, or core, is positioned beneath the upper plate 21 that inherently received loads from the boot 50 when it is attached to the upper plate 21 of the molded frame (See Figure 3).

Thus, Liu fails to teach or suggest a method of manufacturing an in-line skate frame that generally includes positioning core material on a first skin such that the core material is "absent from the shoe load introduction portion," as generally recited in amended Claims 1 and 4. Liu also fails to teach or suggest sealing core material between first and second skins (Claim 1) or sealing core material between a first skin and a decorative layer (Claim 4). Buzza et al. does not teach or suggest what is missing from Liu.

Buzza et al. discloses a fiberglass sandwich panel 100 that includes a top and bottom gel coat resin 24 and 14, a top and bottom fiberglass skin 22 and 16 inside the gel layer, and an inner foam core 20 inside the fiberglass skin. The layers are bonded integrally together during the fabrication of the fiberglass sandwich panel 100 in a heated mold. The core conforms to the shape of the mold; therefore, the fiberglass sandwich panel 100 substantially conforms to the shape of the core. As a result, the core is positioned within the fiberglass skin layers such that the core is exposed to loads imposed on the fiberglass sandwich panel 100.

Thus, Buzza et al. fails to teach or suggest a method of manufacturing a skate frame that includes positioning core material such that it is "absent adjacent the shoe load introduction portion," as generally set forth in amended Claims 1 and 4. Finally, Artus does not address and, therefore, cannot overcome the shortcomings of Liu and Buzza et al.

As seen best by referring to Figure 3, Artus discloses a skate frame having a dampening device 6 disposed within at least one sidewall of a skate frame. The dampening device 6 includes a viscoelastic material 62 and a rigid stress plate 61. Note that a portion of the dampening device 6 is exposed to the operating environment and is *not* sealed within the skate frame. Specifically, in each and every embodiment, at least the stress plate 61 is exposed. In still other embodiments, both the viscoelastic material 62 and the stress plate 61 are exposed to the operating environment. Such a dampening device cannot render obvious Claims 1 and 4.

Thus, Artus fails to teach or suggest a method of constructing a skate frame that includes "forming a second skin over the first skin such that the core material is positioned and *sealed* between the first and second skins," as generally recited in amended Claim 1. Artus also fails to teach or suggest a method of constructing a skate frame that includes "layering a decorative sheet over the core material to *seal* the core material between the first skin and the decorative sheet,"

as now generally recited in amended Claim 4. Instead, Artus expressly teaches a roller skate that includes a dampening device that is *exposed* to the operating environment.

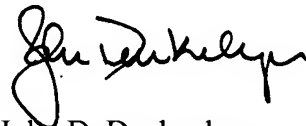
As noted above, there is no teaching or suggestion within either Liu, Buzza et al., and/or Artus to combine the these teachings, as suggested by the Office Action. Moreover, such a hypothetical combination fails to teach or suggest all of the claim limitations of amend Claims 1 and 4. Accordingly, it is respectfully submitted that the rejection of Claims 1 and 4 under 35 U.S.C. § 103 is improper and, therefore, should be withdrawn.

The dependent claims of the present application stem from amended Claims 1 or 4 and, therefore, are patentable. In addition, each dependent claim has patentable subject matter over the cited references of record, including the hypothetical combination of Liu, Buzza et al., and/or Artus. Accordingly, all claims are now in condition for allowance.

The Examiner is invited to telephone the undersigned with any remaining issues regarding this matter.

Respectfully submitted,

CHRISTENSEN O'CONNOR  
JOHNSON KINDNESS<sup>PLLC</sup>



John D. Denkenberger  
Registration No. 44,060  
Direct Dial No. 206.695.1749

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below date.

Date: December 4, 2006

Caedyn K. Johnson

JDD:cg

LAW OFFICES OF  
CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100